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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,065	11/12/2003	Michael Sittinger	27600/X014A	6362
29471	7590	02/12/2008	EXAMINER	
MCCRACKEN & FRANK LLP 311 S. WACKER DRIVE SUITE 2500 CHICAGO, IL 60606			NICHOLSON III, LESLIE AUGUST	
ART UNIT	PAPER NUMBER		3651	
MAIL DATE	DELIVERY MODE			
02/12/2008	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,065	<b>Applicant(s)</b> SITTINGER ET AL.
	<b>Examiner</b> LESLIE A. NICHOLSON III	<b>Art Unit</b> 3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 17 January 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-55 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application<br>Paper No(s)/Mail Date _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

**DETAILED ACTION**

***Oath/Declaration***

1. The affidavit under 37 CFR 1.132 filed 1/17/2008 is insufficient to overcome the rejection of claims 1-55 as set forth in the last Office action.

Affiant argues "It is my belief that each of the ink jet heads disclosed in the cited art inherently includes a speed tracking device that receives timing information from a binding line to enable the ink jet head to synchronize the printed speed thereof with the speed of the binding line" and the demand printer disclosed in Warmus ('599 and '968) prints at a constant speed that does not typically vary in accordance with the speed of the binding line. In response, the Examiner agrees with Affiant's belief.

Affiant further argues a person of ordinary skill in the art would not have had any motivation to combine the demand printer disclosed in Warmus with any of the systems of Dooley, Graushar, or Weller and could not have had a reasonable expectation of success by simply replacing the ink jet heads of the Dooley, Graushar, or Weller with the demand printer disclosed in Warmus ('599 and '968). In response, the Examiner disagrees. One having ordinary skill in the art would be motivated to combine the demand printer disclosed by Warmus with either Dooley, Graushar, or Weller for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run as disclosed by Warmus ('599) in at least C4/L4-8. Replacing the ink jet heads with the demand printer disclosed in Warmus would have had a reasonable expectation of success

because the ink jet heads disclosed by Dooley, Graushar, and Weller, as stated above by Affiant, include a speed tracking device that receives timing information from a binding line to enable the ink jet head to synchronize the printed speed thereof with the speed of the binding line.

Affiant argues the cited art lacks any teaching that would allow a person of ordinary skill in the art to successfully implement a controller that coordinates simultaneous issuance of print commands to the demand printer and operation of the gathering line, the demand printer, and the feeding device. In response, the Examiner disagrees. If neither Dooley, Graushar, nor Weller had the capability of coordinating simultaneous issuance of print commands to the demand printer and operation of the gathering line, the demand printer, and the feeding device, each device would not have the ability to create books at all. If they did not have this ability, the devices would have to be operated manually. Coordinating the timing of the demand printer with other components of the system is an inherent ability of Dooley, Graushar, and Weller.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

#### ***Response to Arguments***

2. Applicant's arguments filed 1/17/2008 have been fully considered but they are not persuasive. Applicant argues the prior art of record does not disclose the limitations of claims 1-55. In response, as previously discussed, Dooley, Graushar, and Weller

disclose all the claim limitations in view of the teachings of Warmus ('599 and '968), Weller, and Graushar.

Applicant further argues the controllers of Dooley, Graushar, and Weller would not be able capable of coordinating a press such that the '599 and '968 references can print in different positions and orientations within the system of Dooley, Graushar, and Weller because there is no disclose in Dooley, Graushar, or Weller as to how the controllers disclosed therein could communicate with the press of the '599 or '968 references. In response, the Examiner disagrees. It is well known in the art for printers to communicate and synchronize with gathering lines and/or feeding devices.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as shown in the current and at least the last action, Warmus and the other teaching references show teaching, suggestion, and motivation to modify Dooley, Graushar, and Weller.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3651

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1,2,8,9,13,23,24,30,31,35,55 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599.

Dooley discloses a book production device that includes a gathering line (14); a demand printer (56); a feeding device (58); a packer box (16) with a transfer mechanism (see col. 4, line 3); and a controller (60). Dooley does not expressly disclose means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page, as taught by Warmus, in the device of Dooley, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

Art Unit: 3651

5. Claims 1,2,12-16,20,22-24,35-38,43-45,49-51,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar USP 5,100,116 in view of Warmus USP 6,327,599.

Graushar discloses a book production device that includes a gathering line (18); a plurality of demand printers (32, see col. 4, line 51); a feeding device (33); and a controller (31). Graushar does not expressly disclose means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page, as taught by Warmus, in the device (or method) of Graushar, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

6. Claims 1,2,6,7,12-18,20,22-24,28,29,35-38,41,43-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weller USP 4,989,850 in view of Warmus USP 6,327,599.

Weller discloses a book production apparatus that includes a gathering line (90); a plurality of demand printers (75, see col. 5, lines 1-6); a feeding device (GR); a folding device (see col. 4, line 56); and a controller (see col. 3, line 56). Weller does not expressly disclose means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page, as taught by Warmus, in the device (or method) of Weller, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

7. Claims 3-5,25-27,39,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar USP 5,100,116 in view of Warmus USP 6,327,599 further in view of Warmus USP 5,963,968.

Graushar discloses all the limitations of the claims, but it does not disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file.

However, Warmus ('968) discloses a book production device that includes disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file for the purpose of producing differing book versions in an efficient manner (see col. 3, lines 8-10).

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Graushar by utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file, as disclosed by Warmus ('968), for the purpose of producing differing book versions in an efficient manner.

8. Claims 10,11,14,17,19,32-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599 further in view of Weller USP 4,989,850.

Dooley discloses all the limitations of the claims, but it does not disclose a folder and it does not disclose a plurality of demand printers.

However, Weller discloses a book production device that includes a folder for the purpose of processing signatures which have not been folded (see col. 3, lines 4-6) and Weller discloses utilizing a plurality of demand printers for the purpose of customizing more than one page.

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a folder and a plurality of demand printers, as disclosed by Weller, for the purpose of processing signatures which have not been folded and customizing more than one page.

9. Claims 14,21,36,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599 further in view of Graushar USP 5,100,116.

Dooley discloses all the limitations of the claims, but it does not disclose a plurality of demand printers.

However, Graushar discloses a book production device that includes a plurality of demand printers for the purpose of customizing more than one page.

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a plurality of demand printers, as disclosed by Graushar, for the purpose of customizing more than one page.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LESLIE A. NICHOLSON III whose telephone number is (571)272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leslie A Nicholson III/  
Examiner, Art Unit 3651  
2/7/2008

/Gene Crawford/  
Supervisory Patent Examiner, Art  
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